

**PATENT APPLICATION
DOCKET NO. 10007652-1**

**IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

INVENTOR(S): Shell S. Simpson

CONFIRMATION NO.: 1943

SERIAL NO.: 09/923,337

GROUP ART UNIT: 2151

FILED: August 8, 2001

EXAMINER: DIVECHA, KAMAL B.

SUBJECT: WEB BASED IMAGING SERVICE THAT CONVERTS WEB PAGES INTO
CONTENT ON BEHALF OF ANOTHER WEB SITE

APPELLANTS'/APPLICANTS' REPLY BRIEF ON APPEAL

In an appeal brief filed September 19, 2006, The Applicant set out the following grounds for rejection to be reviewed and provided argument related to each.

- A. Claims 1-23 were rejected under §112, first paragraph, for failing to comply with the written description requirement.
- B. Claims 1-4, 6-12, and 17-23 were rejected under §102 as being anticipated by US Pub. 2004/0205613 to Li.
- C. Claim 5 was rejected under 35 USC §103 as being unpatentable over US Pub. 2004/0205613 to Li in view of USPN 6,785,022 issued to Todaka.
- D. Claims 13-16 were rejected as being unpatentable over US Pub. 2004/0205613 to Li in view of a publication titled "Using Style Sheets to Publish XML to the Web."

The Examiner responded in an Answer mailed December 19, 2006. The following remarks address the Examiner's Answer.

A. Claims 1-23 were rejected under §112, first paragraph, for failing to comply with the written description requirement.

The Examiner continues to maintain that the Specification does not provide an enabling disclosure with respect to the claim limitation of "selecting an imaging conversion program from a plurality of imaging conversion programs based on the style sheet and the desired format." In support of the rejection, the Examiner states the following at page for of the Answer.

The process of "determining the desired format of the consuming service" has been explicitly disclosed as "optional" (see fig. 13, step #1340, specification, page 64-65 [0184]).

In other words, the disclosed invention can be practiced without determining the desired format of the consuming service, in which case, it would be impossible or nearly impossible to achieve the overall process of

selecting the imaging conversion program from a plurality of programs based on the style sheet and desired format.

The Examiner's reasoning is inconsistent with the basic tenets of Claim construction. Simply because a step is identified as optional in the specification does not mean that the step is option with respect to a claim that recites the step. Claim 1, for example, explicitly recites (a) obtaining a style sheet defining a conversion of the received content to a converted content, (b)determining a desired format for a desired destination for the content, and (c) selecting an imaging conversion program from a plurality of imaging conversion programs based on the style sheet and the desired format. Paragraphs [0182]-[0184] of the Specification discuss and enable the steps of obtaining a style sheet and determining a format. While paragraph [0184] does mention that the step of determining a format is optional, paragraph [0185] discusses that an imaging conversion program is selected from a plurality of imaging conversion programs based on the style sheet and/or the desired format.

The "and/or" conjunction is simply consistent with the notion that the step of determining a format is optional. Where that step of determining a format is not performed, the imaging conversion program is selected from a plurality of imaging conversion programs based on the style sheet. Where that step of determining a format is performed the imaging conversion program is selected from a plurality of imaging conversion programs based on the style sheet **and** the desired format. With respect to the Claims, determining a desired format is not optional as it is recited in various forms in each of the independent claims. As such, those claims also recite in various forms selecting an imaging conversion program from a plurality of imaging conversion programs based on the style sheet **and** the desired format.

Contrary to the Examiner's assertions, even though the specification indicates that determining the desired format is optional, the claims clearly recite elements related to such a determination. As such is not "impossible or nearly impossible to achieve the overall process of selecting the imaging conversion program from a plurality of programs based on the style sheet and desired format."

B. Claims 1-4, 6-12, and 17-23 were rejected under §102 as being anticipated by US Pub. 2004/0205613 to Li.

Claim 1 is directed to a method for providing imaging conversion services on content and recites the following acts:

1. receiving content comprising non-image data;
2. obtaining a style sheet defining a conversion of the received content to a converted content;
3. determining a desired format for a desired destination for the content;
4. selecting an imaging conversion program from a plurality of imaging conversion programs based on the style sheet and the desired format;
5. converting the content using the selected imaging conversion program and the style sheet to obtain the converted content; and
6. transmitting the converted content to the desired destination.

Addressing Claim 1 at page 6 of the Answer, the Examiner improperly rewrites the claims asserting that Li teaches “selecting an imaging conversion program from a plurality of imaging conversion programs based on the style sheet **and/or** the desired format.” The Examiner then goes on to assert that Li teaches such selection based on the style sheet or the desired format but not both. Claim 1 plainly recites that the selection be based on the style sheet **and** the desired format.

This mistaken interpretation of Claim 1 appears to stem from the Examiner’s confusion as to the use of the “and/or” conjunction in the Specification. Paragraphs [0182]-[0184] of the Specification discuss and enable the steps of obtaining a style sheet and determining a format. While paragraph [0184] does mention that the step of determining a format is optional, paragraph [0185] discusses that an imaging conversion program is selected from a plurality of imaging conversion programs based on the style

sheet and/or the desired format. The “and/or” conjunction is simply consistent with the notion that the step of determining a format is optional. Where that step of determining a format is not performed, the imaging conversion program is selected from a plurality of imaging conversion programs based on the style sheet. Where that step of determining a format is performed such as in Claim 1, the imaging conversion program is selected from a plurality of imaging conversion programs based on the style sheet **and** the desired format.

With respect to Claim 1, determining a desired format is not optional as it is a recited element. Remaining consistent, Claim 1 selecting an imaging conversion program from a plurality of imaging conversion programs based on the style sheet **and** the desired format.

For at least this reason Claim 1 is patentable over Li as are Claims 2-18 and 21 which depend from Claim 1.

Claim 19 is directed to a system for implementing the method of Claim 1. For the same reasons Claim 1 is patentable, so are Claim 19 and Claim 22 which depends from Claim 19.

Claim 20 is directed to a computer readable medium containing code for implementing the method of Claim 1. For the same reasons Claim 1 is patentable, so are Claim 20 and Claim 23 which depends from Claim 20.

C. Claim 5 was rejected under 35 USC §103 as being unpatentable over US Pub. 2004/0205613 to Li in view of USPN 6,785,022 issued to Todaka.

Claim 5 depends from Claim 1 and includes all the limitations of that base Claim. For at least the same reasons Claim 1 is patentable, so is Claim 5.

D. Claims 13-16 were rejected as being unpatentable over US Pub. 2004/0205613 to Li in view of a publication titled “Using Style Sheets to Publish XML to the Web.”

Claims 13-16 each depends from Claim 1 and includes all the limitations of that base Claim. For at least the same reasons Claim 1 is patentable, so are Claims 13-16.

For at least the reasons set forth above, the rejections of Claims 1-23 are patentable.

Respectfully submitted,
Shell S. Simpson

By /Jack H. McKinney/
Jack H. McKinney
Reg. No. 45,685

February 20, 2007

APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

1. (previously presented) A method for providing imaging conversion services on content, comprising the steps of:

receiving content comprising non-image data;
obtaining a style sheet defining a conversion of the received content to a converted content;
determining a desired format for a desired destination for the content;
selecting an imaging conversion program from a plurality of imaging conversion programs based on the style sheet and the desired format;
converting the content using the selected imaging conversion program and the style sheet to obtain the converted content; and
transmitting the converted content to a the desired destination.

2. (previously presented) The method as defined in claim 1, wherein the acts of receiving, obtaining, selecting, converting, and transmitting are performed by a web service is at a web site identified by a URL reference.

3. (Previously presented) The method as defined in claim 2, wherein the content is obtained from a source web site that is different from the web service web site; and wherein the obtaining a style sheet step comprises receiving a style sheet from the source web site.

4. (Original) The method as defined in claim 2, wherein the content is obtained from a source web site that is different from the web service web site; and wherein the obtaining a style sheet step comprises selecting a default style sheet.

5. (previously presented) The method as defined in claim 1, wherein the desired destination is a printer having a parameter and wherein the desired format for the printer is related to that parameter.

6. (previously presented) The method as defined in claim 2, wherein selecting an imaging conversion program comprises dynamically selecting an image conversion program based on a negotiation taking place between the web service and a requestor and based on capabilities of each.

7. (Previously presented) The method as defined in claim 1, wherein the transmitting step comprises the step of transmitting the converted content to a consuming web site or service.

8. (Previously presented) The method as defined in claim 1, wherein the transmitting step comprises transmitting the converted content to storage in a personal imaging repository.

9. (Original) The method as defined in claim 1, wherein the transmitting step comprises transmitting a reference to the converted content, with the reference referring to the converted content.

10. (Previously presented) The method as defined in claim 1, wherein the selecting an imaging conversion step comprises associating a reference for the selected imaging conversion program to the content or to a reference for the content and making that content or the content reference accessible to a user, to thereby permit the converting step to be performed on a demand basis.

11. (Original) The method as defined in claim 1, wherein the receiving content step comprises receiving a reference to the content and associating the content reference to a

reference for the web service method and making this content reference accessible to a user, so that the conversion services may be performed on a demand basis.

12. (Previously presented) The method as defined in claim 2, wherein the converted content is stored on the web service.

13. (Previously presented) The method as defined in claim 1, wherein the converting the content step comprises filtering the content to delete selected items therein.

14. (Previously presented) The method as defined in claim 1, wherein the converting the content step comprises labeling different items in the content.

15. (Previously presented) The method as defined in claim 14, further comprising the step of reordering labeled content.

16. (Previously presented) The method as defined in claim 1, wherein the converting the content step comprises changing a layout of the content on a page.

17. (Original) The method as defined in claim 1, wherein said obtaining a style sheet step comprises allowing a user to configure a style sheet for use with the method.

18. (Original) The method as defined in claim 1, wherein the transmitting step comprises transmitting the content to another service.

19. (previously presented) A system for providing imaging conversion services on content, comprising:

a component for receiving content comprising non-image data;

a component for obtaining a style sheet defining a conversion of the received content to a converted content;

a component for determining a desired format for a desired destination for the content;

a component for selecting an imaging conversion program from a plurality of imaging conversion programs based on the style sheet and the desired format;

a component for converting the content using the selected imaging conversion program and the style sheet to obtain converted content; and

a component for transmitting the converted content to a the desired destination.

20. (previously presented) A program product on a computer readable medium for implementing a method when executed on a computing system, the program product comprising:

code for providing imaging conversion services on content;

code for receiving content comprising non-image data;

code for obtaining a style sheet defining a conversion of the received content to a converted content;

code for determining a desired format for a desired destination for the content;

code for selecting an imaging conversion program from a plurality of imaging conversion programs based on the styles sheet and the desired format;

code for converting the received content using the selected imaging conversion program and the style sheet to obtain the converted content; and

code for transmitting the converted content to a desired destination.

21. (Previously presented) The method as defined in claim 1, wherein the converted content comprises an image.

22. (Previously presented) The system as defined in claim 19, wherein the converted content comprises an image.

23. (Previously presented) The program product as defined in claim 20, wherein the converted content comprises an image.